

## REMARKS

Claims 1 – 20 remain in the application. Claims 1 – 16 are amended herein. No new matter has been added.

Claims 1 and 9 are amended to reflect that the operation taking place is prior to and independent of submission to the printer 11. Thus, the claims are amended to recite “opening an original document in a document viewing application, said original document being in a file in memory;” which is supported by the specification, e.g., paragraph 0005 (“It is a purpose of the present invention to improve over existing products by using a standard document viewing application, such as Adobe Acrobat Exchange, Microsoft Word or others, to display the document and the visual feedback cues associated with the currently selected print job parameters.”) Inherent in this is that the document is opened in the particular “standard document viewing application.” Further, it is well known that when “using a standard document viewing application,” a stored file is retrieved into active memory 14 by the processor 12 for display 15. See, e.g., paragraph 0013 (“By using the input devices, an operator may cause the system 10 to retrieve and execute programs and operate on data files which may be stored in the memory 14 or otherwise be accessible to the processor 12 as through a network, from a removable disk or the like.”).

Further, the claims are amended to recite that the result of document manipulation and cue insertion/removal is a job print ticket that the printer uses to print the document. This is supported by paragraphs 0005 (“The job originator then has all the advantages of the viewing application when ticketing the job,”), 06 (“the present invention comprises a set of plug-ins to an existing, standard document viewing application, to let job originators specify job ticket parameters for the entire document and for individual pages and page groups.”), 14 (“For example, dog-ear corners are very useful when editing the

job ticket in the application, but are not desirable in the printed output document. The job ticket parameters represented by the visual cues are stored or printed via the job ticket instead.”) and 16 (“they can adjust the job ticket representation according to the user's actions. The plug-ins can, subject to application limitations, restrict user actions to those that are compatible with job ticketing.”) and by the claims themselves.

Amendments to claims 2, 3, 10 and 11 are supported by paragraph 0014, *supra* (“The job ticket parameters represented by the visual cues are stored or printed via the job ticket instead.”). Moreover, claims 4 and 12 are amended to recite that the unseen cues are not displayed, but are inserted into the working file for job ticket creation/modification. Claims 5 – 8 and 13 – 16 are amended responsive to the amendment to claims 1 and 9. MS Word for example, allows one to select embedded codes, e.g., spaces, tabs, paragraphs, etc., that are displayed or display is selectively suppressed, such that they are unseen. No new matter is added. None of this is taught or suggested by any reference of record. Independent consideration and allowance of claims 1 – 20, as amended, is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request independent consideration and allowance of claims 1 – 20, as amended, and allowance of the application to issue.

As previously noted, MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable

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invention have not been claimed and that if properly claimed such claims  
**may be given favorable consideration.** (emphasis added.)

The applicants continue to believe that the written description of the present application is quite different than and not suggest by any reference of record. Accordingly, should anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

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(Date)

Customer No. 56,989  
Law Office of Charles W. Peterson, Jr.  
435B Carlisle Dr.  
Herndon, VA 20170  
Telephone: (703) 481-0532  
Facsimile: (703) 481-0585

/Charles W. Peterson, Jr., #34,406/  
Charles W. Peterson, Jr.  
Registration No. 34,406